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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/846,931	05/01/2001	Ferdinand Kristen	DT-3899	3652
30377	7590	10/23/2002		
DAVID TOREN, ESQ. SIDLEY, AUSTIN, BROWN & WOOD, LLP 787 SEVENTH AVENUE NEW YORK, NY 10019-6018			EXAMINER HO, TARA	
			ART UNIT 3721	PAPER NUMBER
			DATE MAILED: 10/23/2002	

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Applicant No.	Applicant(s)	
	09/846,931	KRISTEN ET AL.	
	Examiner	Art Unit	
	Tara M. Ho	3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on ____.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-10 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
 5) Claim(s) ____ is/are allowed.
 6) Claim(s) 1-10 is/are rejected.
 7) Claim(s) ____ is/are objected to.
 8) Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 01 May 2001 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 11) The proposed drawing correction filed on ____ is: a) approved b) disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1.) Certified copies of the priority documents have been received.
 2.) Certified copies of the priority documents have been received in Application No. ____.
 3.) Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 09/846931, filed on 05/01/2001.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Reference number 6, the "housing," is not present in the drawing. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

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The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

4. The abstract of the disclosure is objected to because it is in claim format.

Correction is required. See MPEP § 608.01(b).

5. The disclosure is objected to because of the following informalities: the phrase "with respect too the housing" (pg 4 line 2) should be "with respect to the housing," and "ingaging" (pg 9 line 1) should be "engaging," the reference sign "I" used to identify two different oscillation paths, and it's not clear what is meant by a "collectorless rotor."

Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-10 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The interaction between the rotor and stator so as the "protect" the second subassembly from oscillations is not clear. It is also not clear what is meant

by “protecting from oscillations” and “for limited movement along a tool axis.” Is the invention directed to vibration damping? If so, it is not clear how the damping is achieved.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-3, 6 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Schmid et al. ('076).

Schmid et al. discloses an electrical drive 2, a percussion mechanism 22, a rotor 9, a housing 1, a transformation gear 43, a stator Fig. 2, 2 subassemblies with substantially the same mass, and an elastic spring means 32.

9. Claims 1-3, 6-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Eisenhardt ('902).

Eisenhardt discloses a percussion mechanism 5, a rotor Fig. 1, a housing 2, a transformation gear 4, a stator Fig. 1, an elastic spring means 28, and a damping element 31 made of viscous elastic material (col. 4 lines 23-24).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmid et al.

Schmid et al. discloses the invention substantially as claimed except for the control electronics for the electrical drive. However, it is well known in the art to use control electronics for an electrical drive. Therefore, it would have been obvious to make Schmid et al's tool assembly including control electronics for the electrical drive as a matter of design choice. Furthermore, Schmid et al. discloses the invention substantially as claimed except for the collectorless rotor. However, it is well known in the art to use collectorless rotor in an electric tool assembly. Therefore, it would have been obvious to make Schmid et al's tool assembly including a collectorless rotor for the electrical tool assembly as a matter of design choice.

12. Claims 8 –10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmid et al. in view of Eisenhardt ('902).

Schmid et al. discloses the invention substantially as claimed except for the damping element made of viscous elastic material located within the tool. However, Eisenhardt teaches the use of a viscous elastic damping element for the purpose of improving damping during

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rotation within the tool assembly. Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to provide Schmid et al. with a viscous elastic damping element in order to provide better damping during rotation within the electric tool. This modification of Schmid et al. would have been suggested by Eisenhardt which teaches that this type of assembly is old and useful in an electric tool.

13. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eisenhardt.

Eisenhardt discloses the invention substantially as claimed except for the control electronics for the electrical drive. However, it is well known in the art to use control electronics for an electrical drive. Therefore, it would have been obvious to make Eisenhardt's tool assembly including control electronics for the electrical drive as a matter of design choice. Furthermore, Eisenhardt discloses the invention substantially as claimed except for the collectorless rotor. However, it is well known in the art to use collectorless rotor in an electric tool assembly. Therefore, it would have been obvious to make Eisenhardt's tool assembly including a collectorless rotor for the electrical tool assembly as a matter of design choice.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Schwenk, McCarty et al., Bez et al., Weingartner, Honsa et al., and Miescher et al. are cited to show the state of the art.

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15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tara M. Ho whose telephone number is (703)305-8204. The examiner can normally be reached on Mon-Fri 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I. Rada can be reached on (703)308-2187. The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-3579 for regular communications and (703)305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1138.

tmh
October 17, 2002



Rinaldi I. Rada
Supervisory Patent Examiner
Group 3700